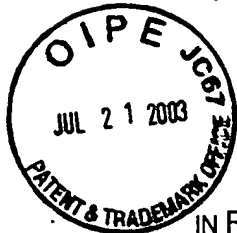


#43

**PATENT****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**IN RE APPLICATION OF: Gough *et al.*

SERIAL No.: 08/963,239

ISSUED: November 3, 1997

FOR: MULTIPLE ANTENNA ABLATION APPARATUS AND METHOD

EXAMINER: Peffley, M.

ART UNIT: 3739

CONFIRMATION No.: 9828

Petition under 37 C.F.R. §1.47(b)

Applicants hereby petition, under 37 C.F.R. §1.47(b), to make the present application on behalf of the omitted inventors, Edward J. Gough, Alan A. Stein, and Stuart D. Edwards, who have refused to join in the application. Provided herein, in accordance with this section, are proof of the pertinent facts, the last known address of the inventors, and the petition fee.

Declaration of Facts

1. I, the undersigned, am the agent of record for this case. The following describes my knowledge of the situation.

2. Edward J. Gough and Alan A. Stein were listed as co-inventors on the subject application as filed. Following work on the invention, they left employment at Rita Medical Systems, Inc, the Assignee of record. The most recent known addresses of the parties involved are:

Edward J. Gough
1925 13th Avenue
Sacramento, CA 95818
Telephone: (650) 574-2867

Alan A. Stein
649 Lancaster Blvd. Moss Beach, CA 94038
Telephone: (650) 728-5007.

Stuart D. Edwards
1681 Austin Avenue
Los Altos, CA 94024

3. The application was filed on November 3, 1997. A Declaration executed by inventors Edward J. Gough and Alan A. Stein on January 19, 1998 was mailed to the U.S. Patent and Trademark Office on April 1, 1998.

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4. Due to claim amendments during prosecution, it became apparent that Stuart D. Edwards should be added as an inventor in the instant application.

5. On February 27, 2003, our office forwarded a letter to Stephen Williams, Chief Operating Officer (COO) at Rita Medical Systems, Inc., enclosing a Declaration for execution by Edward J. Gough, Alan A. Stein, and Stuart D. Edwards. It is our standard policy to send these documents to the Assignee.

6. In a meeting with Stephen Williams on April 2, 2003, he indicated his office had been having difficulty obtaining the signatures and I offered to re-send the documents directly to the inventors.

7. On April 8, 2003, our office forwarded a Declaration to Edward J. Gough at the following address:
31 Anderson Way
Menlo Park, CA 94025

8. On April 8, 2003, our office forwarded the Declaration (referenced in point 7 above) to Alan A. Stein and Stuart D. Edwards via Federal Express to the above-referenced address.

9. On April 9, 2003, Dr. Stein contacted my office to discuss the Declaration. He indicated that he was reluctant to sign the Declaration. I forwarded a letter addressing his concerns and enclosing a copy of the application with all amendments to date via facsimile on the same date.

10. On April 9, 2003, I became aware that the address I had for Dr. Gough was not current. I contacted Dr. Gough by telephone and he gave me the above-referenced address. On April 9, 2003, our office forwarded the Declaration (referenced in point 7 above) as well as a copy of the application with all amendments to date via Federal Express to the above referenced address.

11. On April 10, 2003, Dr. Stein contacted my office to again discuss the Declaration. He indicated that he is unwilling to sign the Declaration at this time.

12. On July 4, I left a telephone message for Dr. Gough at the above-referenced telephone number to inquire about the documents.

13. Applicant's enclose herewith documentation of the above-referenced events:

a. A copy of a letter dated February 27, 2003 from Perkins Coie LLP to Stephen J. Williams of Rita Medical Systems, Inc. enclosing the Declaration for signature by the inventors.

b. A copy of letters dated April 8, 2003 from Perkins Coie LLP to Edward J. Gough, Alan A. Stein, and Stuart D. Edwards, respectively, enclosing the Declaration via Federal Express.

c. A copy of the Federal Express shipment tracking showing delivery of the documents mailed on April 8, 2003 to Dr. Stein on April 9, 2003 at 11:30 am.

d. A copy of the Federal Express shipment tracking showing delivery of the documents mailed on April 8, 2003 to Dr. Edwards on April 9, 2003 at 1:48 pm.

e. A copy of the Federal Express shipment tracking showing delivery of the documents mailed on April 9, 2003 to Dr. Gough on April 11, 2003 at 2:37 p.m.

f. A copy of the fax dated April 9, 2003 from Perkins Coie LLP to Alan A. Stein addressing his concerns regarding the Declaration and enclosing a copy of the application, as amended, and a copy of the transmission confirmation.

Conclusion

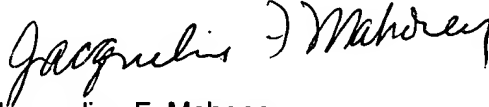
The inventors were thus presented with a copy of the complete application papers, in accordance with MPEP §409.03(d), in addition to receiving the documents to be signed.

Applicants submit that this petition complies with the requirements of 37 C.F.R. §1.47(a) and MPEP §409.03(d), and gives documented evidence that the missing inventors refused to join in the application after a diligent effort was made to obtain their signature on the application papers.

Fee Payment

- ☒ Petition Fee (37 C.F.R. §1.17(h): \$130.00
- ☒ A check including the fee is enclosed.
- ☒ Please charge any additional fees necessary for consideration of this paper to Deposit Account No. 50-2207.

Respectfully submitted,


Jacqueline F. Mahoney
Registration No. 48,390

Date: July 21, 2003

Correspondence Address:

Customer No. 22918
Phone: (650) 838-4300



Jacqueline F. Mahoney
(650) 838-4410
jfmahoney@perkinscoie.com

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FAX: 650.838.4350
www.perkinscoie.com

February 27, 2003

Stephen J. Williams
Chief Operating Officer
Rita Medical Systems, Inc.
967 North Shoreline Blvd.
Mountain View, CA 94043

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JUL 28 2003
TECHNOLOGY CENTER R3700

Re: U.S. Patent Application No. 08/963,239
for MULTIPLE ANTENNA ABLATION APPARATUS AND METHOD
Your Reference: 13724-787
Our Reference: 37167-8026

Dear Steve:

Enclosed for your information and files is a copy of an amendment and associated documents as filed in the U.S. Patent and Trademark Office on February 21, 2003 in the above-referenced patent application.

In the response, we re-established the claim to priority to the 08/148,439 application which was filed Nov. 11, 1993, now U.S. Pat. No. 5,458,597. In order to perfect this priority claim, we amended the inventorship to add Stuart D. Edwards as an inventor. We submitted an unexecuted Declaration and Statement by the inventor with the response, however, we will need to obtain signatures for these documents and forward them to the USPTO. Please find enclosed a Declaration for signature by Edward J. Gough, Alan A. Stein and Stuart D. Edwards and a Statement under §1.48(a)(2) that only needs to be signed by Stuart D. Edwards. Please let us know if you need any assistance in obtaining these signatures.

Also, as this action was a Final Office action, we may not make amendments as a matter of right. If the Examiner refuses to enter the amendment, we will need to file a Request for Continued Examination (RCE) to enter the amendment, which reverses the finality of the Office action for a fee.

If you have any questions, please feel free to contact our offices.

Very truly yours,

Jacqueline F. Mahoney
Patent Agent

JFM/lba
Encs.



Jacqueline F. Mahoney
650 838-4410
jfmahoney@perkinscoie.com

37167-8026

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FAX: 650.838.4350
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April 8, 2003

Via Federal Express

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TECHNOLOGY CENTER R3700

Edward J. Gough
31 Anderson Way
Menlo Park, CA 94025

RE: Rita Medical Systems, Inc.
U.S. Patent Application Serial No. 08/963,239 filed on November 3, 1997
for MULTIPLE ANTENNA ABLATION APPARATUS AND METHOD
Rita Ref. No. 13724-787
Our Ref No. 37167-8026

Dear Mr. Gough:

To complete the requirements of the U.S. Patent and Trademark Office, it is necessary for us to submit newly executed Declaration of Inventorship in the above-referenced patent application on which you are named as an inventor. Accordingly, enclosed is a Declaration of Inventorship for your signature and return. Please make sure you **date** the document, as well. The signature need not be notarized or witnessed. Please also check your personal data for accuracy. If there are any errors (*e.g.* incorrect address or spelling), please make the necessary corrections and initial and date them.

For your convenience, we have enclosed a self-addressed federal express envelope for ease of return of the **signed and dated** document.

Your prompt assistance is appreciated.

If you have any questions, please do not hesitate to contact our offices.

Yours very truly,

Jacqueline F. Mahoney
Patent Agent

JFM/lba
Encs.



Jacqueline F. Mahoney
650 838-4410
jfmahoney@perkinscoie.com

37167-8026

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April 8, 2003

Via Federal Express

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TECHNOLOGY CENTER R3700

Alan A. Stein
649 Lancaster Blvd.
Moss Beach, CA 94038

RE: Rita Medical Systems, Inc.
U.S. Patent Application Serial No. 08/963,239 filed on November 3, 1997
for MULTIPLE ANTENNA ABLATION APPARATUS AND METHOD
Rita Ref. No. 13724-787
Our Ref No. 37167-8026

Dear Mr. Stein:

To complete the requirements of the U.S. Patent and Trademark Office, it is necessary for us to submit newly executed Declaration of Inventorship in the above-referenced patent application on which you are named as an inventor. Accordingly, enclosed is a Declaration of Inventorship for your signature and return. Please make sure you **date** the document, as well. The signature need not be notarized or witnessed. Please also check your personal data for accuracy. If there are any errors (e.g. incorrect address or spelling), please make the necessary corrections and initial and date them.

For your convenience, we have enclosed a self-addressed federal express envelope for ease of return of the **signed and dated** document.

Your prompt assistance is appreciated.

If you have any questions, please do not hesitate to contact our offices.

Yours very truly,

Jacqueline F. Mahoney
Patent Agent

JFM/lba
Enc.



Jacqueline F. Mahoney
650 838-4410
jfmahoney@perkinscoie.com

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FAX: 650.838.4350
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April 8, 2003

Via Federal Express

Stuart D. Edwards
1681 Austin Avenue
Los Altos, CA 94024

RE: Rita Medical Systems, Inc.
Our Ref. 37167-8000

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TECHNOLOGY CENTER R3700

Dear Mr. Edwards:

To complete the requirements of the U.S. Patent and Trademark Office, it is necessary for us to submit newly executed Declarations of Inventorship in four of the patent applications on which you are named as an inventor. Accordingly, enclosed are four Declarations of Inventorship for your signature and return. Please make sure you date the documents, as well.

Also, in order to add you as an inventor in one of the patent applications, enclosed is a Statement of Inventor Being Added. Please **sign and date** this document as well. The signatures need not be notarized or witnessed. Please also check your personal data for accuracy. If there are any errors (*e.g.* incorrect address or spelling), please make the necessary corrections and initial and date them.

For your convenience, we have enclosed a self-addressed federal express envelope for ease of return of the five **signed and dated** documents.

Please return the declarations and the statement as soon as possible, your prompt assistance is appreciated.

If you have any questions, please do not hesitate to contact our offices.

Yours very truly,

Jacqueline F. Mahoney
Patent Agent

JFM/lba
Encs.



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Delivery Location: 649 LANCASTER BLVD
Delivery Date: April 9, 2003
Delivery Time: 1130

Shipping Information:

Tracking No: 830149467926

Ship Date: April 8, 2003

Recipient:

ALAN A STEIN

-
649 LANCASTER BLVD
MOSS BEACH, CA 94038
US

Shipper:

JACQUELINE MAHONEY
PERKINS COIE LLP
101 JEFFERSON DR
MENLO PARK, CA 94025
US

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Delivery Date: April 9, 2003
Delivery Time: 1348

Shipping Information:

Tracking No: 830149467797

Ship Date: April 8, 2003

Recipient:

STUART EDWARDS
-
1681 AUSTIN AVE
LOS ALTOS, CA 94024
US

Shipper:

JACQUELINE MAHONEY
PERKINS COIE LLP
101 JEFFERSON DR
MENLO PARK, CA 94025
US

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Signed For By: E.GOUGH

Delivery Location: 1925 13TH AVE

Delivery Date: April 11, 2003

Delivery Time: 1437

Shipping Information:

Tracking No: 830149468017

Ship Date: April 9, 2003

Recipient:

EDWARD GOUGH

-

1925 13TH AVE
SACRAMENTO, CA 95818
US

Shipper:

JACQUELINE MAHONEY
PERKINS COIE LLP
101 JEFFERSON DR
MENLO PARK, CA 94025
US

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Menlo Park, CA 94025-1114
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FAX: 650.838.4350
www.perkinscoie.com

April 9, 2003

Via Facsimile

Dear Dr. Stein:

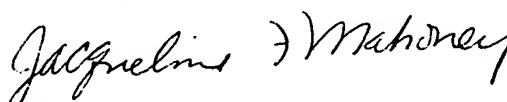
As we discussed, I am sending a copy of the patent application and the pending claims that correspond to the inventor declaration at issue. I have also attached a table showing the impressive line of patents in this family that has evolved from your discoveries. I would note that U.S. Patent No. 5,683,384 seems to correspond to the patent you mentioned on the phone as an earlier document naming Drs. Edwards and Gough, along with you, as co-inventors.

To ease your concerns about signing the revised inventor declaration to add S. Edwards as an inventor in the application, I offer the following comments.

1. **Dr. Edwards should be added as an inventor in this case** because the claims relate to a method of volumetric ablation using the device invented by Dr. Edwards. The presently claimed method requires use of a device having at least one RF electrode that defines an ablation volume when deployed. This device description corresponds to the device claimed in U.S. Patent Nos. 5,458,597 and 5,536,267 on which Dr. Edwards is the named inventor.
2. **It is desirable to add S. Edwards as an inventor** for two reasons. First, naming of the true and correct inventors is necessary for validity of any patent that may issue from the application. Second, addition of Dr. Edwards as an inventor allows us to claim priority back at least to U.S. Patent No. 5,536,267, and thus remove this document cited by the U.S. Examiner against the pending claims.
3. **Your signature on this Declaration merely affirms that you are an inventor of the claimed material.** To assist you with understanding the legalese in the Declaration, I have attached an explanation for the first four paragraphs of the Declaration.
4. **We do not expect that your further participation will be required** for the continued prosecution of this application before the U.S. PTO.

I can appreciate your concerns and frustrations, given the long time lapse since the initial filing of this application and the history that has transpired since this. I hope that these comments alleviate your concerns sufficiently to permit a certain level of comfort in signing the documents. If you have any questions, please feel free to call me.

Yours very truly,


Jacqueline F. Mahoney
Patent Agent

JFM/lba
Enc.